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PATENT
450100-02165

REMARKS

In the office action, Claims 1-9 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,781,435 to Holroyd et al. in view of U.S. Patent No. 5,206,929 to Langford et al. The rejection is traversed for at least the following reasons.

Independent claim 1 recites in pertinent part "editing mode selecting means for selecting a linear or non-linear editing mode; wherein said recording and reproducing means operate in a bound state."

With respect to the Examiner's reliance upon official notice to reject claim 1, it is submitted that though MPEP 2144.03 allows the Examiner to support an obviousness rejection based on common knowledge in the art or "well-known" prior art, the MPEP also provides that "*if the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.*" (emphasis added) The examiner's assertion is respectfully traversed, it is respectfully submitted that an "editing mode selecting means for selecting a linear or non-linear editing mode" for an A/V server as recited in claim 1 is not "notoriously well known." Contrary to the Examiner's assertion, those portions of Holroyd to which the Examiner refers do not suggest that the editing mode can be a linear or a non-linear mode. There is no suggestion in the reference of selecting one or the other mode. Accordingly, if the Examiner insists on maintaining this ground for the rejection it is requested that he provide the reference or references upon which he relies for his assertion.

Next, in the office action, the Examiner looks to Holroyd for a definition of the term "bound state." It is submitted that because applicants have provided a definition of the bound state and the act of binding, use of a definition outside of the specification is improper. In the application at page 19, line 6, applicants have clearly defined "binding" as "a state in which a recording port and a reproducing port are selected as a set." Use of this definition is required for

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the Examiner's analysis of the term "bound state" or binding, as used in the claims of the instant application, as the applicants have acted as their own lexicographer. Consequently, claim 1 calls for recording and reproducing means to be selected as a set. As described in the specification, this allows "the linear editing system to operate the A/V server 1 in the same way as the VTR equipment." (Page 19, lines 20-21). As clarified by the specification, without operation in the bound state "it is necessary to create a pre-view image virtually by an external switcher if an output during a pre-view or editing is to be viewed, thus increasing the number of equipments [sic] and complicating the control software." (Page 20, lines 1-3).

Bearing in mind the definition provided by the Applicants it is submitted that the relied upon portion of Langford fails to teach "recording and reproducing means [that] operate in a bound state." The Examiner relies upon Fig. 4 as supporting the assertion that Langford teaches operation in a bound state. Nowhere in Fig. 4 or in the analysis of Fig. 4 at col. 6, lines 3-21 is there a description of operation in a bound state as that term is defined by the Applicants. Because as the Examiner admits, there is no such teaching in Holroyd, it is submitted that claim 1 patentably distinguishes over the relied upon portions of the cited references and is allowable. Independent claims 8 and 9 recite similar limitations as claim 1 and are believed to be similarly allowable.

Claims 2-7 depend from claim 1, and, due to such dependency, are believed to be distinguishable from Holroyd and Langford for at least the same reasons. Accordingly it is submitted that claims 1-9 patentably distinguish over the relied upon portions of the cited references and are allowable.

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CONCLUSION

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosures in the cited reference, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.